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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,984	07/09/2001	Peter Gatis	11422-002001	6864

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FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

ZHOU, TING

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,984

Applicant(s)

GATIS, PETER

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on 19 April 2004 have been received and entered. Claims 1-31 as amended are pending in the application. Claims 32-34 have been cancelled by the applicant and therefore, withdrawn from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. U.S. Patent 6,009,442.

Referring to claims 1, 16 and 31, Chen et al. teach an apparatus for displaying a graphical user interface (GUI) and computer program stored on a computer-readable medium for viewing and manipulating a composite document (clipped document as disclosed in column 4, lines 43-48 and shown in Figures 2B and 3) comprised of separate documents having an ordered relationship, as recited in column 1, lines 64-67 and continuing onto column 2, lines 1-3. Specifically, Chen et al. teach a memory that stores executable instructions and a processor that executes the instructions (general purpose computer recited in column 3, lines 37-51) to generate an area for displaying the separate documents (document viewing utility), a control for use in selecting the separate documents for display in accordance with the ordered relationship

(document browsing utility) and an option to display the separate documents conjoined (displaying a clipped document, which combines the separate documents into a compound document; therefore, the separate documents of the compound documents are displayed conjoined) (column 15, lines 1-9 and further shown in Figure 12) and such that content of the separate documents is editable from the area (the user is provided with the option of adding annotations to a document and also, cut and paste all or a part of a document) (column 12, lines 10-13 and 34-35, column 15, lines 10-21 and column 18, lines 43-55). This is further recited in column 11, lines 25-30 and column 14, lines 60-69 and shown in Figures 10-13.

Referring to claims 2 and 17, Chen et al. teach a scroll bar for scrolling through the separate documents, as shown in Figure 12.

Referring to claims 3 and 18, Chen et al. teach a tree structure having the separate documents as selectable branches, as recited in column 5, lines 3-26 and shown in the left display panel of Figure 12.

Referring to claims 4 and 19, Chen et al. teach one or more buttons for scrolling through the separate documents (icons or thumbnails representing the separate documents), as recited in column 11, lines 43-57.

Referring to claims 5 and 20, Chen et al. teach the one or more tabs for selecting the separate documents, as shown in Figures 14 and 15.

Referring to claims 6 and 21, Chen et al. teach altering the ordered relationship (monitoring and updating the order as the result of the addition, deletion and modification of the documents) of the separate documents, as recited in column 6, lines 33-45.

Referring to claims 7 and 22, Chen et al. teach a drag bar for dragging and dropping the documents to a position relative to the other separate documents, as recited in column 16, lines 7-63.

Referring to claims 8 and 23, Chen et al. teach a notes section (annotations utility “177” shown in Figure 1B) for adding notations relating to at least one of the separate documents, as recited in column 18, lines 42-55.

Referring to claims 9 and 24, Chen et al. teach an options section (toolbar) for displaying one or more options that can be performed on the separate documents, as recited in column 12, lines 43-59. This can further be seen in Figure 12. This panel contains a display of icons on the toolbar displayed at the top of the figure representing actions that can be performed on the documents.

Referring to claims 10 and 25, Chen et al. teach the options section comprising an option to print one of the separate documents, as recited in column 11, lines 30-36 and evidenced by the print function icon shown in Figure 12.

Referring to claims 11 and 26, Chen et al. teach one of the separate documents heading a hierarchy of subdocuments and the GUI further comprising an area for displaying that hierarchy, as recited in column 11, lines 25-30. This can also be seen by the hierarchical tree structure in Figures 3 and 12.

Referring to claims 12 and 27, Chen et al. teach the subdocuments displayed to reflect their hierarchical relationship to the head of the hierarchy, as shown in Figure 12. For example, it is evident from viewing the display that “Medical” is a subset of “All Documents”, which is in turn a subset of “Indexed Categories”.

Referring to claims 13 and 28, Chen et al. teach an area for displaying identifying information (summary information contained in property sheets) for the separate documents, as recited in column 2, lines 7-16 and column 18, lines 56-67.

Referring to claims 14 and 29, Chen et al. teach the separate documents comprising of an image document and a text document, as recited in column 15, lines 33-36.

Referring to claims 15 and 30, Chen et al. teach options for editing the separate documents (manipulating the documents such as copying and moving and consolidating the documents), as recited in column 11, lines 30-37 and column 12, lines 10-12.

Response to Arguments

3. Applicant's arguments filed on 19 April 2004 have been fully considered but they are not persuasive.

4. The applicant asserts that the Chen et al. reference does not disclose or suggest an option to display the separate documents conjoined and such that content of the separate documents is editable from a display area. However, Chen et al. teach the ability to display clipped documents, which combines several component documents (column 15, lines 1-9 and 29-31). Therefore, the separate component documents can be displayed, conjoined as a compound document. In addition, from the display area (document viewing user interface for example, toolbars include options such as annotating the documents (column 15, lines 1-21). Although the user can manipulate the conjoined, or compound document as a group, each component document can also be manipulated individually (column 15, lines 51-54). Therefore, the user is

presented with the option of annotating the separate documents, which changes, or edits the content of the documents. Furthermore, cutting, copying and pasting all or a part of the information on the documents also edits the documents by changing its content. Therefore, it can be seen that the Chen et al. reference anticipates the subject invention

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

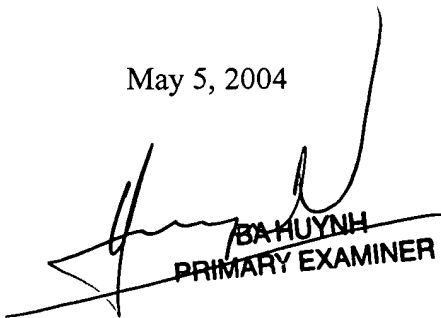
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday - Friday 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 5, 2004


BA HUYNH
PRIMARY EXAMINER